REMARKS

In response to the **Three Month** Action mailed June 14, 2005, the restriction requirement is respectfully traversed. The Official Action has not established a prima facie justification for the restriction requirement. In the Official Action, the Examiner has required restriction, under 35 USC § 121, between the following groups of claims:

I. Claims 1-13, drawn to a semiconductor integrated circuit device comprising a decoupling capacitor formed at an interface between the first conductivity type semiconductor substrate and second conductivity type semiconductor layer, classified in class 257, subclass 595, and

II. Claims 24-34, drawn to a semiconductor integrated circuit device comprising a pn junction between the first region and second region acts [sic] as a decoupling capacitor suppressing a variation of at least one of voltage supplied by the first and second power supplies, classified in class 257, subclass 599.

In making the restriction requirement, the Examiner asserts "Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a decoupling capacitor could be used for reducing the frequency noise for the circuitry, however invention II has separate utility such as a decoupling capacitor could suppress a variation of at least one of voltages supplied by first and second power supplies." Even assuming arguendo invention I may have separate utility, invention I is generic, and invention II falls within the scope of invention I.

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In requiring restriction, the Examiner also noted that the inventions are classified in different classes, thus alluding to the fact that the inventions would involve divergent fields of search. However, as the Examiner is well aware, such a factor per se is not a basis for determining distinctiveness in accordance MPEP § 806.

Furthermore, it is respectfully submitted that there is nothing in 35 USC § 121 that gives the Patent Office the authority to require restriction between statutory classes of claims unless the claims cover "independent and distinct inventions". It is respectfully submitted that the statutory requirements, not having been met here for Groups I and II respective, the Examiner should withdraw the requirement for restriction and provide Applicant with an action on the merits of the withdrawn claims.

It should be noted that the restriction requirement as prescribed by 35 USC § 121 are discretionary with the Examiner, and in view of the remarks above, the restriction requirement should be withdrawn. In summary therefore, all of the claims are believed to be directed to a single invention. However, so as to be fully responsive, Applicants provisionally elect to prosecute Group I, i.e., claims 1-13, and it is requested that, without further action thereon, claims 24-34 be retained in this application pending disposition of the application, and for possible rejoinder and/or for filing of a divisional application.

An action on the merits is respectfully requested.

While this second Action was a restriction requirement, the Action was marked as being a three month Action. Therefore, it is believed an extension of time is not needed. However, in the event an extension of time is needed, the Commissioner is authorized to consider this a request for extension, and charge our deposit account No. 08-1391 the cost of the extension.

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Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: MAIL STOP AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 19, 2005, at Tucson, Arizona.

By

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